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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,215	03/18/2004	Simon Daniel Brueckheimer	920476-904607A	5835
23644 7590 01/08/2008 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786			EXAMINER DUONG, FRANK	
			ART UNIT 2616	PAPER NUMBER
			NOTIFICATION DATE 01/08/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent-ch@btlaw.com

## Office Action Summary

Application No.

10/803,215

Applicant(s)

BRUECKHEIMER ET AL.

Examiner

Frank Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-104 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/09/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is a response to communications dated 03/18/04. Claims 11-104 are pending in the application.

#### ***Inventorship***

2. In view of the papers filed 04/11/07, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by deleting Roy Harold Mauger and substituting David John Stacey as an inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

#### ***Claim Objections***

3. Claims 65 and 81 are objected to because of the following informalities:

As per claim 61, it is an improper dependent claim. It should depend from either claim 66, 63, 62 or 58 instead of method claim 16.

As per claim 81, line 1, "theassebley" should be changed to --the assembly--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 58-77 are rejected under 35 U.S.C 112, first paragraph, as based on a single means claim, i.e. (*means of assembling; means for storing or a multiplexer*), where a means recitation does not appear in combination with another recited element of means. A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor. It has been held in Hyatt that when claims depend on a recited property, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983).

5. Claims 58-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For the same rationales discussed in the single means rejection, a question of enablement is raised because in the original specification, there is neither support or discussion that each claimed element can be enabled without the interaction or interconnection with or to other elements.

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***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 11-104 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,731,635.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following rationales:

**Base claim 11 of the instant application is a representative claim and it calls for:**

A method of assembling traffic from a plurality of users for transmission over an ATM connection, said method comprising:

**assembling the plurality of users' traffic into respective mini-cells;**

for each of said plurality of users' traffic, **storing information pertaining to a mini-cell length associated with that user's mini-cells;** and **multiplexing the mini-cells into ATM cells.**

**Base claim 1 of the '635 patent is a representative claim and it claims:**

A method of transmitting traffic from a plurality of users over an ATM virtual circuit connection, the method including **storing** at an interface with the ATM network for each said user, **a correspondence between a circuit identifier and a cell length indicator for that user,** **segmenting each user's traffic and packaging the segmented user traffic into minicells,** **encapsulating the minicells from a plurality of users into ATM cells,** each of the minicells incorporating the respective circuit identifier for each said user, transmitting the ATM cells over the connection, determining from the stored correspondence for each said user the length of the minicells associated with that user so as to effect delineation of the minicells contained in each said transmitted ATM cell on egress from the ATM virtual circuit connection at the interface, and disassembling the delineated minicells so as to recover each user's traffic.

First, one can clearly see through claims comparison that base claim 11 of the instant application is a broad version of base claim 1 of the '635 patent with the omission of the limitations not highlighted and not underscored. However, it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ

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184(CCPA). Also note *Ex Parte Rainu*, 168 USPQ 375 (Bd. App. 1969); omission of a reference whose function is not needed would be an obvious variation.

Second, the terms assembling, storing and multiplexing bolded in claim 11 of the instant application are obviously corresponding to the terms segmenting and packaging; storing; and encapsulating of claim 1 of the '635 patent. These terms are used interchangeably in drafting the claims by those skilled in the art.

Third, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Base claims 31, 58 and 78 of the instant application are obvious over base claims 11 and 12 of the '635 patent for the same rationales discussed above.

Dependent claims 12-30, 32-57 and 79-104 appear to be obvious over dependent claims 2-11 and 13-20 of the '635 patent for the rationales discussed above.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eneroth et al (USP 6,341,131) is considered the closest reference for it discloses the use of channel identifier (CID) to indicate the length of the mini-cells. However, its filing date (01/27/1997) in the United States cannot be relied upon to qualify as the prior art.

Takashima et al (USP 5,509,007).

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Petersen et al (USP 5,802,050).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**FRANK DUONG  
PRIMARY EXAMINER**

December 28, 2007